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| APPLICATION NO.                                       | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|---|-------------|----------------------|----------------------|------------------|
| 09/925,696  | 08/09/2001  | Ing Vojtech Benetka  | PH44                 | 4284             |
| 26841   | 7590        | 01/26/2005           | EXAMINER             |                  |
| MARK P. BOURGEOIS<br>P.O. BOX 95<br>OSCEOLA, IN 46561 |             |                      | GRUNBERG, ANNE MARIE |                  |
|   |             |                      | ART UNIT             | PAPER NUMBER     |
|   |             |                      | 1661                 |                  |
| DATE MAILED: 01/26/2005                               |             |                      |                      |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application N .

09/925,696

Applicant(s)

BENETKA ET AL.

Examin r

Anne Marie Grunberg

Art Unit

1661

-- The MAILING DATE of this communication appears n the c ver sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

Because the name was changed due to a trademark issue, the objection to the name has been withdrawn.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Plant Breeder's Right documents AU PBR 1998014, granted 9/13/1999 as grant number 1325; and CZ PBR 0WEI06556, granted 5/31/1996 as grant number 679, each published more than one year prior to the filing of the U.S. application in light of Applicant's admission that 'Pink Poppet' was on sale in The Czech Republic as of 1995. 'Pink Poppet' is the same plant as 'Piccolo' and 'Plangen'.

Claim 1 is drawn to an weigela plant named 'Pink Poppet'.

The cited publications each teach the weigela plant 'Pink Poppet'.

In response to the 105 Requirement for Information, Applicant admits that first sales of the instant plant took place in 1995 in the Czech Republic. This, in combination with the above described UPOV applications elicits a 102(b). See below for more information.

The claimed weigela variety 'Pink Poppet' is described in the Plant Breeder's Rights cited above and published more than one year prior to filing in the U.S.

The published grant, application and published proposed denomination are each "printed publications" under 35 U.S.C. 102 because they are accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 226, 210 USPQ 790, 792 (CCPA 1981). See also MPEP § 2128. For example, UPOV publishes the application number and grant number, date of publication, species of plant and variety denomination for PBR certificates, and copies of the grant are obtainable through UPOV. Thus, information regarding the claimed variety, in the form of the publications noted above, was readily available to interested persons of ordinary skill in the art.

One of ordinary skill in the art would have been able to propagate the claimed weigela without undue experimentation given that the method of propagating weigelas was widely known in the art as evidenced by the RHS Dictionary of Gardening, at the bottom of page 702 and top of page 704. Barring evidence to the contrary, the sale of weigela more than a year prior to filing in the U.S. was not a single isolated event. One of ordinary skill in the art would have been able to determine where to buy the plant by contacting the breeder as listed by UPOV.

A printed publication can serve as a statutory bar under 35 U.S.C 102(b) if the reference, combined with knowledge in the prior art, would enable one of ordinary skill in the art to reproduce the claimed plant. *In re LeGrice*, 301 F.2d 929, 133 USPQ (CCPA 1962). If one skilled in the art could reproduce the plant from a publicly available source, then a publication describing the plant would have an enabling disclosure. See *Ex parte Thomson*, 24 USPQ2d 1618, 1620 (Bd. Pat. App. & Inter. 1992) ("The issue is not whether the [claimed] cultivar Siokra

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was in public use or sale in the United States but, rather, whether Siokra seeds were available to a skilled artisan anywhere in the world such that he/she could attain them and make/reproduce the Siokra cultivar disclosed in the cited publications.”)

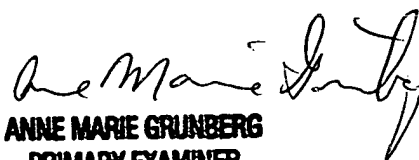
Since one skilled in the art could reproduce the plant because it was readily available to the public, then the above referenced publications had an enabling disclosure.

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anne Marie Grünberg whose telephone number is (571) 272-0975. The examiner can normally be reached from Monday through Thursday from 7:30 until 5:00, and every other Friday from 7:30 until 4:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811. The fax number for the unit is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (571) 272-1600.

  
**ANNE MARIE GRÜNBERG**  
**PRIMARY EXAMINER**